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09/399,578	09/20/1999	DANIEL L. MARKS	AIS-P99-1	2427
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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In re Application of: MARKS, Daniel L.
Application No. **09/399,578**
Filed: September 20, 1999
Atty Docket No.: AIS-P99-1
For: **REAL TIME COMMUNICATIONS
SYSTEM**

DECISION ON PETITION
UNDER 37 C.F.R. § 1.181
TO WITHDRAW FINALITY OF
OFFICE ACTION

This is a decision on the petition filed August 28, 2012 treated in accordance with 37 CFR § 1.181 to invoke Supervisory Authority and require the Examiner to “reopen prosecution for compliance with the MPEP”, as best understood, withdraw the Finality of office action mailed February 28, 2012.

The petition is **DISMISSED**.

RELEVANT PROSECUTION HISTORY

02/28/12 Final action was mailed. Disposition of the claims was claims 1-37 of instant application. The record is unclear as to what claims of instant application against the following copending applications:

Claims of instant application were provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-37 of copending application number 11/836,633.

Claims of instant application were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-63 of copending Application No. 11/510,351.

Claims of instant application were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-58 of copending application No. 11/510,463.

Claims of instant application were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-84 of copending Application No. 11/836,473.

Claims 1-17, 35-74, 86-164, 166-206, 224-291, 309-366, 376-408, 41 O, 413-430, 450-502, 504-508, 526-536, 538-553, 555-570, 572-631, 726-754, 846-862, 877-878, 884-885, 891-892, 955-962, 973-976, 978-983, 985-988 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown et al in view of Tarau et al.

LogiMOO: an Extensible Multi-user Virtual World with natural language control. Further, claims 862-876, 879-883, 886-890, 963-972, 977, 989-995 are withdrawn.

04/30/12 First Amendment and Request for Reconsideration After Final was filed, including a request for reconsideration and declaration of Professor Lee Hollaar as opinion testimony under 37 C.F.R. 1.132 (MPEP §716.019(c)).

05/25/12 Advisory Action was mailed including granting entry to After Final filed 04/30/12.

08/28/12 Second Amendment and Request for Reconsideration After Final was filed.

08/28/12 Notice of Appeal was filed.

08/28/12 Pre-Brief Conference request was filed.

08/03/12 Petition to reopen prosecution for compliance with the MPEP, Rules, and status is filed.

09/10/12 IDS was filed.

08/03/12 Notice of Defective Pre-Brief Conference.

10/19/12 Final Rejection

PERTINENT STATUTES, RULES & REGULATIONS

MPEP 706.07(a) states in part that:

Under present practice, second or any subsequent action on the merits shall be made final, except where the examiner introduces a new ground of rejection not necessitated by amendment of the application by the applicant, whether or not the prior art is already of record.

MPEP 706.07(d) states in part that:

If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection

MPEP § 1201 states, in part:

The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director) should be carefully observed. The Board will not ordinarily hear a question that should be decided by the Director on petition, and the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board.

§ 1.113 Final rejection or action.

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

716 Affidavits or Declarations Traversing Rejections, 37 CFR 1.132

37 CFR 1.132. Affidavits or declarations traversing rejections or objections.

When any claim of an application or a patent under reexamination is rejected or objected to, any evidence submitted to traverse the rejection or objection on a basis not otherwise provided for must be by way of an oath or declaration under this section.

It is the responsibility of the primary examiner to personally review and decide whether affidavits or declarations submitted under 37 CFR 1.132 for the purpose of traversing grounds of rejection are responsive to the rejection and present sufficient facts to overcome the rejection.

This rule sets forth the general policy of the Office consistently followed for a long period of time of receiving affidavit evidence traversing rejections or objections. All affidavits or declarations presented which do not fall within or under other specific rule are to be treated or considered as falling under this rule.

716.01(c) OPINION EVIDENCE

Although factual evidence is preferable to opinion testimony, such testimony is entitled to consideration and some weight so long as the opinion is not on the ultimate legal conclusion at issue. While an opinion as to a legal conclusion is not entitled to any weight, the underlying basis for the opinion may be persuasive. In *re* Chilowsky, 306 F.2d 908, 134 USPQ 515 (CCPA 1962) (expert opinion that an application meets the requirements of 35 U.S.C. 112 is not entitled to any weight; however, facts supporting a basis for deciding that the specification complies with 35 U.S.C. 112 are entitled to some weight); In *re* Lindell, 385 F.2d 453, 155 USPQ 521 (CCPA 1967) (Although an affiant's or declarant's opinion on the ultimate legal issue is not evidence in the case, "some weight ought to be given to a persuasively supported statement of one skilled in the art on what was not obvious to him." 385 F.2d at 456, 155 USPQ at 524 (emphasis in original)).

In assessing the probative value of an expert opinion, the examiner must consider the nature of the matter sought to be established, the strength of any opposing evidence, the interest of the expert in the outcome of the case, and the presence or absence of

factual support for the expert's opinion. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986). See also *In re Oelrich*, 579 F.2d 86, 198 USPQ 210 (CCPA 1978) (factually based expert opinions on the level of ordinary skill in the art were sufficient to rebut the prima facie case of obviousness); *Ex parte Gray*, 10 USPQ2d 1922 (Bd. Pat. App. & Inter. 1989) (statement in publication dismissing the "preliminary identification of a human b-NGF-like molecule" in the prior art, even if considered to be an expert opinion, was inadequate to overcome the rejection based on that prior art because there was no factual evidence supporting the statement); *In re Carroll*, 601 F.2d 1184, 202 USPQ 571 (CCPA 1979) (expert opinion on what the prior art taught, supported by documentary evidence and formulated prior to the making of the claimed invention, received considerable deference); *In re Beattie*, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992) (declarations of seven persons skilled in the art offering opinion evidence praising the merits of the claimed invention were found to have little value because of a lack of factual support); *Ex parte George*, 21 USPQ2d 1058 (Bd. Pat. App. & Inter. 1991) (conclusory statements that results were "unexpected," unsupported by objective factual evidence, were considered but were not found to be of substantial evidentiary value).

Although an affidavit or declaration which states only conclusions may have some probative value, such an affidavit or declaration may have little weight when considered in light of all the evidence of record in the application. *In re Brandstadter*, 484 F.2d 1395, 179 USPQ 286 (CCPA 1973).

An affidavit of an applicant as to the advantages of his or her claimed invention, while less persuasive than that of a disinterested person, cannot be disregarded for this reason alone. *Ex parte Keyes*, 214 USPQ 579 (Bd. App. 1982); *In re McKenna*, 203 F.2d 717, 97 USPQ 348 (CCPA 1953).

716.01(d) Weighing Objective Evidence

IN MAKING A FINAL DETERMINATION OF PATENTABILITY, EVIDENCE SUPPORTING PATENTABILITY MUST BE WEIGHED AGAINST EVIDENCE SUPPORTING PRIMA FACIE CASE

When an applicant timely submits evidence traversing a rejection, the examiner must reconsider the patentability of the claimed invention. The ultimate determination of patentability must be based on consideration of the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

The submission of objective evidence of patentability does not mandate a conclusion of patentability in and of itself. *In re Chupp*, 816 F.2d 643, 2 USPQ2d 1437 (Fed. Cir. 1987). Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of a prima facie case was reached, not against the conclusion itself. *In re Eli Lilly*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990). In other words, each piece of rebuttal evidence should not be evaluated for its ability to knockdown the prima facie case. All of the competent rebuttal evidence taken as a whole should be weighed against the evidence supporting the prima facie case. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Although the record may establish evidence of secondary considerations which are indicia of nonobviousness, the record may also establish such a strong case of obviousness that the objective evidence of

nonobviousness is not sufficient to outweigh the evidence of obviousness. *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 769, 9 USPQ2d 1417, 1427 (Fed. Cir. 1988), cert. denied, 493 U.S. 814 (1989); *Richardson-Vicks, Inc., v. The Upjohn Co.*, 122 F.3d 1476, 1484, 44 USPQ2d 1181, 1187 (Fed. Cir. 1997) (showing of unexpected results and commercial success of claimed ibuprofen and pseudoephedrine combination in single tablet form, while supported by substantial evidence, held not to overcome strong prima facie case of obviousness). See *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984) for a detailed discussion of the proper roles of the examiner's prima facie case and applicant's rebuttal evidence in the final determination of obviousness.

If, after evaluating the evidence, the examiner is still not convinced that the claimed invention is patentable, the next Office action should include a statement to that effect and identify the reason(s) (e.g., evidence of commercial success not convincing, the commercial success not related to the technology, etc.). See *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir.), cert. denied, 488 U.S. 956 (1988). See also MPEP § 716.01. See MPEP §2145 for guidance in determining whether rebuttal evidence is sufficient to overcome a prima facie case of obviousness.

1002.02(c) Petitions and Requests Decided by the Technology Center Directors

(d) relative to formal sufficiency and propriety of affidavits under 37 CFR 1.131 (MPEP § 715.08), 1.132 (MPEP § 716) and 1.608, MPEP § 2308 - § 2308.02;

715.08 Passed Upon by Primary Examiner

The question of sufficiency of affidavits or declarations under 37 CFR 1.131 should be reviewed and decided by a primary examiner.

Review of questions of formal sufficiency and propriety are by petition filed under 37 CFR 1.181. Such petitions are answered by the Technology Center Directors (MPEP § 1002.02(c)).

Review on the merits of a 37 CFR 1.131 affidavit or declaration is by appeal to the Board of Patent Appeals and Interferences.

DECISION

Applicant's arguments have been fully considered.

1. Arguments regarding improper provisional double patenting rejection because only one claim element was considered, thus not complying with the noted sections of the MPEP.

(i) A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at **least one** examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); and *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Thus, in determining whether a nonstatutory basis exists for a double patenting rejection, if **any claim** in the application define an invention that is anticipated by, or is merely an obvious variation of, a nonstatutory double patenting rejection is appropriate. (see MPEP 804 (II)(1)). However, Final

action mailed 02/28/12, fails to state what claims of instant application were rejected as being unpatentable over claims of copending applications 11/510,351, 11/510,463, 11/510,473 and 11/836,633, thus, it is deemed improper. Noted deficiency has been corrected in final action mailed 10/19/12 (p. 3-10).

(ii) Currently, there is no legal requirement to provide a "mapping or matrix" of the limitations for the five (5) pending patent application. Section of the MPEP §804 quoted by petitioner, has been considered, however, found that the quote pertains to the "analysis employed parallels the Graham v. John Deere that are applied for establishing a background", not a mandated/requirement to provide "mapping or matrix" of the conflicting claims, so as long the obviousness-type double patenting rejection makes clear: (A) the differences between the inventions defined by the conflicting claims a claim in the patent compared to a claim in the application; and (B) the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is anticipated by, or would have been an obvious variation of, the invention defined in a claim in the patent.

Section of the MPEP §2142 quoted by petitioner, has been considered, i.e. "burden of factual supporting [of] any prima facie conclusion of obviousness". The conclusion of obviousness-type double patenting is made in light of these factual determinations. Any obviousness-type double patenting rejection should make clear: (A) and (B) above mentioned. (MPEP 804(II)(B))

In accordance to the record, a Final Rejection (dated 10/19/12) includes the above-mentioned nonstatutory obviousness-type provisional double patenting rejection set forth on Final action dated 02/28/12, namely, against copending application number **09/399,578** filed 09/20/1999, copending Application No. **11/510,463** filed 08/24/06, copending application No. **11/510,473** filed 08/24/06 and copending Application No. **11/510,351** filed 08/24/06, Final Rejection (dated 10/19/12) presents a reasonable conclusion of obviousness-type double patenting making clear: (A) the differences between the inventions defined by the conflicting claims a claim in the patent compared to a claim in the application; and (B) the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is anticipated by, or would have been an obvious variation of, the invention defined in a claim in the patent. This analysis employed parallels the guidelines for analysis of a **35 U.S.C. 103** obviousness determination.

Section of the MPEP §2143 quoted by petition has been considered, however, the provisional rejections sets forth the differences between the inventions defined by the conflicting claims a claim in the patent compared to a claim in the application, as a factual determination that has been made clear of record. In this case, there is no statement on the record as a whole asserting that all words in the claim have not been considered in judging the patentability of that claim against the prior art. The record has been reviewed, the Final Rejection (dated 10/19/12) includes the above-mentioned provisional nonstatutory obviousness-type provisional rejection in a clear fashion, the set forth requirements (A) and (B), were found reasonable and the analysis employed parallels the guidelines for analysis of a **35 U.S.C. 103** obviousness determination.

Section of the MPEP §706 quoted by petitioner has been considered, however, this section does not require setting forth a mapping/matrix of the conflicting claims, nevertheless, the nonstatutory obviousness-type provisional rejection included in the Final Rejection (dated 10/19/12), presents a reasonable conclusion of obviousness-type double patenting making clear the requirements (A) and (B) discussed above.

Section of the MPEP §132 and §104(a)(2) quoted by petition has been considered, with respect to instant application “multiple reference double patenting rejection”, the nonstatutory obviousness-type provisional rejection included in the Final Rejection (dated 10/19/12), purports a conclusion of obviousness-type double patenting in accordance with the requirements (A) and (B) above mention, thus, setting forth the “reasons for such requirements”, hence, the record is found reasonable and sufficient.

2. Argument regarding the improper handling of substantive interview due to non-entry of the Examiner’s Interview Summary of interview with Dr. Chandrajit Bajaj, Professor Lee Hollar, Applicant’s representative and Examiner’s Supervisor.

Opinion testimony Affidavit/declaration filed under 37 C.F.R. 1.132 on 08/18/11 by Dr. Chandrajit Bajaj filed attest regarding the Shastra article that “there was no capability of a database which serves as a repository of tokens for other programs to access, thereby affording information to otherwise independent participator computers.”

(i) At the moment of Dr. Chandrajit Bajaj affidavit filing, the pending claims 1-995 (as of 09/23/08) did not recite “...repository of tokens...”.

(ii) Subsequent office action following the declaration by Dr. Chandrajit Bajaj, namely, final action mailed 02/28/12 does not include a rejection which relies for the basis of a rejection under 35 U.S.C. §103/102 on the article “Shastra - An Architecture for Development of Collaborative Applications, Proceedings on Second Workshop on Enabling Technologies: Infrastructure for Collaboration Enterprises, April 1993, pages 155-166 by Vinod Anumpam & Chandrajit Bajaj.

(iii) The affidavit/declarations, and accompany evidence traversing the rejection was acknowledged and commented upon in the next succeeding action, namely, final office action mailed 02/28/12, shows an explanation as to why the affidavit filed on August 18, 2011 was deemed insufficient to overcome the rejection under U.S.C. §103(a) of claims 1-291, 309-366, 376-502, 504-519, 521-536, 538-553, 555-570, 572-590, 592-995 unpatentable over Shastra in view of Ahuja et al. (dated 01/21/11). (MPEP §716.01)

(iv) Currently there is no interview summary neither from the examiner, nor applicant for the substance of an interview conducted on 11/17/11, other than a brief request for interview in applicant’s remarks filed 10/27/11 and 04/30/12 and statements of the substance of interviews prior to November 2011. The record of instant application is unclear as to whether or not the interview conducted on this date for co-pending application, included an interview for instant application. Upon review of the record, Interview agenda emailed on the morning of the interview for copending application 11/510,351, indicates that it was directed to application 11/510,351 alone. Hence, given that there is no evidence on the record that an interview was conducted on 11/17/11 for this instant application, arguments that the Examiner’s handling of the substantive interview is non-compliant with MPEP §713.04 are rendered moot.

Applicant is encourage that if the record needs to be clarified, a request for supervisory patent examiner (SPE’s) reconsideration via a petition under §1.181 should be filed regarding this matter.

4. Failure to provide Rule 104 and section 132 information.

Applicant states the remarks by examiner filed 04/17/12 fails to provide “any information as to how the declaration of Dr. Chandrajit Bajaj could be insufficient when the PTO has the

burden of proof...the Examiner provided no evidence whatsoever to contradict the declaration of Dr. Chandrajit Bajaj...". The record has been reviewed, however, there is no communication from the Office nor Applicant on that date.

(i) Affidavit filed 08/18/12 by Dr. Chandrajit Bajaj states in sum [as best understood] regarding the Shastra article "there was no capability of a database which server as a repository of tokens for other programs to access, thereby affording information to otherwise independent participator computers" (item # 7, p. 2).

(ii) The pending claims at the moment of the filing of this affidavit (i.e. claims filed 09/23/08) has been reviewed, however, (1) none of claims 1-995, recite the limitation/feature which the declaration states the applied reference Shastra does not disclose.

(iii) Subsequent rejection after the filing of the Affidavit filed 08/18/12 by Dr. Chandrajit Bajaj, namely, final rejection (mailed 02/28/12) does not include a rejection does not rely for the basis rejection under 35 U.S.C. §103/102 on the article "Shastra - An Architecture for Development of Collaborative Applications, Proceedings on Second Workshop on Enabling Technologies: Infrastructure for Collaboration Enterprises, April 1993, pages 155-166 by Vinod Anumpam & Chandrajit Bajaj.

4. Regarding arguments for alleged "failure to give proper care/consideration to a declaration... evidence of unobviousness."

(iv) Final Action mailed 02/28/12 provides a response to the submission of affidavit filed under 37 C.F.R. 1.132 (see page 4-5). This response provides an explanation as to why the affidavit by Dr. Chandrajit Bajaj was deemed insufficient to overcome the rejection under U.S.C. §103(a) of claims 1-291, 309-366, 376-502, 504-519, 521-536, 538-553, 555-570, 572-590, 592-995 unpatentable over Shastra in view of Ahuja et al. (dated 01/21/11). The comments have reasonably and sufficiently explained why the evidence is insufficient. While an opinion as to a legal conclusion is not entitled to any weight, the underlying basis for the opinion has been fully considered, however, not found to be persuasive. Although factual evidence is preferable to opinion testimony, provided expert opinion/testimony have been extended consideration and some weight, so long as the opinion is not on the ultimate legal conclusion at issue. It is noted that, the submission of objective evidence of patentability does not mandate a conclusion of patentability in and of itself. *In re Chupp*, 816 F.2d 643, 2 USPQ2d 1437 (Fed. Cir. 1987).

5. Regarding evidence of unobviousness which allegedly received no consideration, namely, Affidavit filed (4/30/12) by Professor Lee A. Hollaar, petitioner's arguments have been fully considered. The remarks accompanying the affidavit refer to the declaration by Dr. Chandrajit Bajaj (p. 157) and not Professor Lee A. Hollaar, nevertheless, according to the record outstanding office action (final action 10/19/12) does not include a rejection, which relies for the basis rejection under 35 U.S.C. §103/102 on the article "Shastra - An Architecture for Development of Collaborative Applications, Proceedings on Second Workshop on Enabling Technologies: Infrastructure for Collaboration Enterprises, April 1993, pages 155-166 by Vinod Anumpam & Chandrajit Bajaj. Hence, arguments in this regard have been fully considered, but are moot in view of the record.

6. Final office action mailed 10/19/12, has reset the short statutory period for response, thus, providing application the provisioned opportunity to reply under §1.113 to this final office action. (see MPEP §714.12) It is respectfully noted that if there is a disagreement between the

examiner and applicant's counsel as to whether the prior art teaches (or not) all claimed limitation(s) of claims 1-988. The ultimate determination of obviousness is a legal conclusion, the underlying Graham vs. John Deere Co. inquiries are factual (see MPEP §2141). Such a disagreement regarding claim interpretation and set forth rejection supporting a conclusion of patentability is appealable, not a petitionable matter.

For the above mentioned reasons, the petition is **DISMISSED**.

Any inquiry concerning this decision should be directed to Beatriz Prieto whose telephone number is (571) 272-3209. Second point of contact is Chris Grant whose telephone number is (571) 272-7294.

/Beatriz Prieto/
Beatriz Prieto
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